

REMARKS

Claims 1-3, 5-8, 10-15, 17-21, and 23-33 are currently pending, with claims 1, 5, 6, 10-13, 19, and 25-27 being amended by this Reply. Claims 1, 6, 11-13, 19, and 25-27 are independent. Favorable reconsideration and allowance of the present application are respectfully requested in view of the following remarks.

Claim Rejections - 35 U.S.C. §103(a)

Claims 1-3, 5-8, 10-15, 17-21, and 23-33 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,799,219 to Moghadam et al. (“Moghadam”) in view of U.S. Patent No. 5,930,810 to Farros et al. (“Farros”). As applied to the claims as amended, Applicants submit the Examiner has failed to establish a *prima facie* case of obviousness and traverse the rejection.

For a 35 U.S.C. § 103 rejection to be proper, a *prima facie* case of obviousness must be established. *See M.P.E.P. 2142*. One requirement to establish *prima facie* case of obviousness is that the prior art references, when combined, must teach or suggest all claim limitations. *See M.P.E.P. 2142; M.P.E.P. 706.02(j)*. Thus, if the cited references fail to teach or suggest one or more elements, then the rejection is improper and must be withdrawn.

As amended, independent **claim 1** recites, *inter alia*, a method comprising the steps of:

recording, in a portable recording medium, high resolution picture image data obtained by reading a developed film and further recording, in the same portable recording medium, printing service information regarding one or more available printing services which can be provided for the high resolution picture image data, said printing service information being updateable information which represents an updated selection of one or more available printing services for said image data;

reading said printing service information from said portable recording medium using order processing software installed on a personal computer of a user;

updating a selection of available printing services to be displayed by the order processing software, based on the read printing service information;

displaying an order screen on a display of the personal computer of the user, wherein said order screen is created by the order processing software and comprises the updated selection of said one or more available printing services and at least one of the picture image data recorded in the portable recording medium; and

generating print ordering information in response to a user selection of at least one of said picture image data and at least one of the one or more printing services displayed on said order screen.

The Moghadam reference has been relied upon by the Examiner, and has been interpreted by the Board of Patent Appeals and Interferences (BPAI) in the Decision of April 30, 2007, to allegedly teach recording high resolution picture data and recording printing service information that can be provided for the high resolution image picture data in the same portable recording medium. More specifically, the Board has interpreted the temporary buffer memory 138 of Moghadam to be a portable recording medium because it is removably attached to the PC. *See Decision, page 4.*

However, in this instance, the combination of Moghadam and Farros fails to teach or suggest each and every limitation of amended claim 1. Moghadam cannot disclose or render obvious the method of claim 1 as amended, wherein the printing service information is read from the portable recording medium using order processing software installed on a personal computer of a user and wherein a selection of available printing services to be displayed by the order processing software is updated, based on the read printing service information. Farros has not been, and indeed cannot be, relied upon to correct at least this deficiency of Moghadam. Dependent claims 2, 3, 5, and 28 are also distinguishable from the prior art at least due to their dependence from claim 1.

Therefore, Applicants submit that claims 1-3, 5, and 28 are patentable over the prior art and respectfully request that the rejection of claims 1-3, 5, and 28 under §103(a) be withdrawn.

As amended, independent **claim 6** recites, *inter alia*, a print ordering system comprising:

printing service information recording means which records, in a portable recording medium, high resolution picture image data obtained by reading a developed film and further records, in the same portable recording medium, printing service

information regarding one or more available printing services which can be provided for the high resolution picture image data by a related service provider, said printing service information being updateable information which represents an updated selection of one or more available printing services for said image data;

reading means which reads said printing service information from said portable recording medium;

updating means for updating a selection of available printing services to be displayed;

display means which displays an order screen, wherein said order screen comprised the updated selection of said one or more available printing services and at least one of the picture image data recorded in the portable recording medium.

As discussed with respect to claim 1 above, the Moghadam reference has been interpreted to allegedly teach recording high resolution picture data and recording printing service information that can be provided for the high resolution image picture data in the same portable recording medium. However, the combination of Moghadam and Farros fails to teach or suggest each and every limitation of amended claim 6. Moghadam cannot disclose or render obvious the system of claim 6 as amended, comprising printing service information recording means, reading means, and updating means as recited. Farros has not been, and indeed cannot be, relied upon to correct at least these deficiencies of Moghadam. Dependent claims 7, 8, 10, and 29 are also distinguishable from the prior art at least due to their dependence from claim 1, directly or indirectly.

Therefore, Applicants submit that claims 6-8, 10, and 29 are patentable over the prior art and respectfully request that the rejection of claims 6-8, 10, and 29 under §103(a) be withdrawn.

As amended, independent **claim 11** recites, *inter alia*, a photo finishing system comprising print ordering information obtaining means which obtains print ordering information generated based on a user selection of at least one picture image data and at least one of one or more updated printing services displayed on an order screen, said order screen being displayed by order processing software installed on a personal computer of said user, wherein said updated printing services represents an updated

selection of one or more available printing services for said image data based on updateable printing service information stored in the same portable recording medium as the image data, and wherein said order processing software reads the updateable printing service information from the portable recording medium in order to display the updated printing services on the order screen.

As discussed with respect to claim 1 above, the Moghadam reference has been interpreted to allegedly teach recording high resolution picture data and recording printing service information that can be provided for the high resolution image picture data in the same portable recording medium. However, the combination of Moghadam and Farros fails to teach or suggest each and every limitation of amended claim 11. Moghadam cannot disclose or render obvious the system of claim 11 as amended, wherein the printing service information is read from the portable recording medium using order processing software installed on a personal computer of a user and wherein a selection of available printing services to be displayed by the order processing software is updated, based on the read printing service information. Farros has not been, and indeed cannot be, relied upon to correct at least these deficiencies of Moghadam.

Therefore, Applicants submit that claim 11 is patentable over the prior art and respectfully request that the rejection of claim 11 under §103(a) be withdrawn.

As amended, independent **claim 12** recites, *inter alia*, a recording medium wherein a program is stored by means of which a computer generates print ordering information in order to order a print of a picture image, said print ordering information comprising electronic data in a predetermined standard to be processed by a predetermined photo finishing system, the program comprising at least the step of:

displaying, on a display apparatus connected to a personal computer of a user, an order screen comprising a selection of available printing service information and high resolution picture image data, said order screen displayed by order processing software which updates the selection of available printing service information based on updateable printing service information stored in the same portable recording medium as the image data, and wherein said order processing software reads the updateable printing service information from the portable recording medium in order to display the updated printing services on the order screen.

As discussed with respect to claim 1 above, the Moghadam reference has been interpreted to allegedly teach recording high resolution picture data and recording printing service information that can be provided for the high resolution image picture data in the same portable recording medium. However, the combination of Moghadam and Farros fails to teach or suggest each and every limitation of amended claim 12. Moghadam cannot disclose or render obvious the program of claim 12 as amended, wherein updated printing services are displayed on an order screen on a display of a personal computer of a user by order software which updates the selection of available printing service information based on the printing service information stored with the picture image data in the portable recording medium. Farros has not been, and indeed cannot be, relied upon to correct at least these deficiencies of Moghadam.

Therefore, Applicants submit that claim 12 is patentable over the prior art and respectfully request that the rejection of claim 12 under §103(a) be withdrawn.

As amended, independent **claim 13** recites, *inter alia*, a method comprising the steps of:

recording, in a portable recording medium, high resolution picture image data, obtained by reading a developed film and further recording, in the same portable recording medium, printing service information regarding one or more printing services, which can be provided for the high resolution picture image data, said recording being performed by a photo finishing system, said printing service information being updateable information which represents an updated selection of one or more available printing services for said image data;

reading said printing service information from said portable recording medium using a personal computer of a user;

updating a selection of available printing services to be displayed by the personal computer of the user, based on the read printing service information;

displaying the updated printing service information and the high resolution picture image data from the portable recording medium using the personal computer of the user.

As discussed with respect to claim 1 above, the Moghadam reference has been interpreted to allegedly teach recording high resolution picture data and recording printing service information that can be provided for the high resolution image picture

data in the same portable recording medium. However, the combination of Moghadam and Farros fails to teach or suggest each and every limitation of amended claim 13. Moghadam cannot disclose or render obvious the method of claim 13 as amended, wherein the printing service information is read from the portable recording medium using order processing software installed on a personal computer of a user and wherein a selection of available printing services to be displayed by the order processing software is updated, based on the read printing service information. Farros has not been, and indeed cannot be, relied upon to correct at least these deficiencies of Moghadam. Dependent claims 14, 15, 17, 18, and 30 are also distinguishable from the prior art at least due to their dependence from claim 13, directly or indirectly.

Therefore, Applicants submit that claims 13-15, 17, 18, and 30 are patentable over the prior art and respectfully request that the rejection of claims 13-15, 17, 18, and 30 under §103(a) be withdrawn.

As amended, independent **claim 19** recites, *inter alia*, a picture print ordering system comprising:

a first recording unit for recording, in a portable recording medium, high resolution picture image data obtained by reading a developed film and further recording, in the same portable recording medium, printing service information regarding one or more printing services which can be provided for the high resolution picture image data, said recording being performed by a photo finishing system, said printing service information being updateable information which represents an updated selection of one or more available printing services for said image data;

a reading unit for reading said printing service information from said portable recording medium;

an updating unit for updating a selection of available printing services to be displayed for a user, based on the read printing service information;

for use in generating an updateable order screen displaying available printing services from which a user selects;

a display unit for displaying the updated printing service information and the high resolution picture image data from the portable recording medium at a user's personal computer; and

a generating unit for generating print ordering information identifying print services desired for the high resolution picture image data based on a user selection of desired print services, using the displayed printing service information.

As discussed with respect to claim 1 above, the Moghadam reference has been interpreted to allegedly teach recording high resolution picture data and recording printing service information that can be provided for the high resolution image picture data in the same portable recording medium. However, the combination of Moghadam and Farros fails to teach or suggest each and every limitation of amended claim 19. Moghadam cannot disclose or render obvious the system of claim 19 as amended, wherein the printing service information is read from the portable recording medium using order processing software installed on a personal computer of a user and wherein a selection of available printing services to be displayed by the order processing software is updated, based on the read printing service information. Farros has not been, and indeed cannot be, relied upon to correct at least these deficiencies of Moghadam. Dependent claims 20-24 and 31 are also distinguishable from the prior art at least due to their dependence from claim 19, directly or indirectly.

Therefore, Applicants submit that claims 19-24, and 31 are patentable over the prior art and respectfully request that the rejection of claims 19-24, and 31 under §103(a) be withdrawn.

As amended, independent **claim 25** recites, *inter alia*, a photo finishing system comprising:

a print ordering information obtaining unit which obtains print ordering information regarding the high resolution picture image data from the user; and

a print generating unit which carries out a variety of printing processes based on the print ordering information,

wherein the print ordering information is generated based on a user selection of at least one picture image data and at least one of one or more updated printing services displayed on an order screen, said order screen being displayed by order processing software installed on a personal computer of said user, wherein said updated printing services represents an updated selection of one or more available printing services for said image data based on updateable printing service information stored in the same

portable recording medium as the image data, and wherein said order processing software reads the updateable printing service information from the portable recording medium in order to display the updated printing services on the order screen.

As discussed with respect to claim 1 above, the Moghadam reference has been interpreted to allegedly teach recording high resolution picture data and recording printing service information that can be provided for the high resolution image picture data in the same portable recording medium. However, the combination of Moghadam and Farros fails to teach or suggest each and every limitation of amended claim 25. Moghadam cannot disclose or render obvious the system of claim 25 as amended, wherein the printing service information is read from the portable recording medium using order processing software installed on a personal computer of a user and wherein a selection of available printing services to be displayed by the order processing software is updated, based on the read printing service information. Farros has not been, and indeed cannot be, relied upon to correct at least these deficiencies of Moghadam.

Therefore, Applicants submit that claim 25 is patentable over the prior art and respectfully request that the rejection of claim 25 under §103(a) be withdrawn.

As amended, independent **claim 26** recites, *inter alia*, a computer program embodied on a computer-readable medium for ordering prints comprising:

a recording source code segment for recording, in a portable recording medium, full image picture data obtained by reading a developed film and further recording, in the same portable recording medium, printing service information regarding one or more printing services which can be provided for the high resolution picture image data, said recording being performed by a photo finishing system, said printing service information being updateable information which represents an updated selection of one or more available printing services for said image data;

a reading source code segment for reading said printing service information from said portable recording medium;

an updating source code segment for updating a selection of available printing services to be displayed, based on the read printing service information; and

a displaying source code segment for displaying the updated printing service information and the high resolution picture image data from the portable recording medium on a display of a computer of a user.

As discussed with respect to claim 1 above, the Moghadam reference has been interpreted to allegedly teach recording high resolution picture data and recording printing service information that can be provided for the high resolution image picture data in the same portable recording medium. However, the combination of Moghadam and Farros fails to teach or suggest each and every limitation of amended claim 26. Moghadam cannot disclose or render obvious the computer program of claim 26 as amended, comprising a recording source code segment, a reading source code segment, an updating source code segment, and a displaying source code segment, as recited. Farros has not been, and indeed cannot be, relied upon to correct at least these deficiencies of Moghadam. Dependent claim 32 is also distinguishable from the prior art at least due to their dependence from claim 26.

Therefore, Applicants submit that claims 26 and 32 are patentable over the prior art and respectfully request that the rejection of claims 26 and 32 under §103(a) be withdrawn.

As amended, independent **claim 27** recites, *inter alia*, a medium comprising:

a first recording area for recording picture image data with high resolution; and

a second recording area for recording information regarding one or more available printing services which can be provided for the high resolution picture image data, said printing service information being updateable information which represents an updated selection of one or more available printing services for said image data, wherein the picture image data with high resolution and the information regarding printing services are provided together to a customer;

wherein the customer orders a print out by selecting an updated printing service from an order screen created according to the updateable information regarding printing services and the picture image data with high resolution having been read from said medium at the customer's computer using order processing software; and

wherein said medium is a portable recording medium, such that the high resolution image data and the printing service information are stored on the same portable recording medium.

As discussed with respect to claim 1 above, the Moghadam reference has been interpreted to allegedly teach recording high resolution picture data and recording printing service information that can be provided for the high resolution image picture data in the same portable recording medium. However, the combination of Moghadam and Farros fails to teach or suggest each and every limitation of amended claim 27. Moghadam cannot disclose or render obvious the medium of claim 27 as amended, wherein the customer orders a print out by selecting an updated printing service from an order screen created according to the updateable information regarding printing services and the picture image data with high resolution having been read from said medium at the customer's computer using order processing software. Farros has not been, and indeed cannot be, relied upon to correct at least these deficiencies of Moghadam. Dependent claim 33 is also distinguishable from the prior art at least due to their dependence from claim 27.

Therefore, Applicants submit that claims 27 and 33 are patentable over the prior art and respectfully request that the rejection of claims 27 and 33 under §103(a) be withdrawn.

CONCLUSION

All objections and rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance. Notice of same is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John R. Sanders at the telephone number below, in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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